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09/921,589	08/03/2001	Michael Wen-Chein Yang	POLY-1194	1853

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
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1752

18

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/921,589

Applicant(s)

YANG ET AL.

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-14 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-14, 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 10-14, 18-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,605,410 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Patent claims 8-9 present an element which anticipates that of instant claims 10, 14 and 20 because the polyamides in the ablation layer in the Patent claim anticipates the Markush member polyamides in the instant claims wherein 10.6 um is an IR wavelength used to ablate.

Although the conflicting claims are not identical, they are not patentably distinct from each other because instant applicant's claim is broader and more generic than the (Patent or copending application) claim is. ***The examiner notes for the record that applicants added "polyamide" to the instant claims in the last amendment.*** Thus, instant applicant's claims 10, 14 and 20 are anticipated by Patent claims 8- 9. See particularly See *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993). Patent claims 1-14 teach the modifications to make to the Patent

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element which are inclusive of all the limitations set forth in the application claims 11-13, 18-19.

Thus, modifying the photopolymerizable layer to contain the listed photopolymers (Patent claims 3-4), limiting the amount of UV absorber (patent claim 5), limiting the UV absorbers to a specific set (Patent claim 10) and making the backing layer transparent (Patent claim 2) would have been obvious variants of the plates of Patent claims 8-9 in view of their modification being set forth with respect to the generic patent claim 1.

3. Claims 10-14, 17-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to instant claims 10-14 and 17-20, the photosensitive element claims requires the presence of "at least one ablation layer which is ablatable by infrared radiation and opaque to non-infrared actinic radiation, ..., the infrared ablation layer comprising: at least one ultraviolet radiation absorbing material ; and at least one binder that is selected from the group consisting of polyacetals, polyacrylics, polyamides, polyimides, polybutylenes, polycarbonates, polyesters, polyethylenes, polyphenylene ethers, or polyethylene oxides; wherein the ablation layer is ablatable from the surface of the photopolymerizable layer upon exposure to infrared laser radiation." The original specification and claims do not disclose this generic ablation layer drawn to infrared ablation and infrared absorbing material with the exception of showing with Example 3 that polyamide slip containing Uvinul D 50 are not ablatable with a YAG laser which is an infrared laser and that they are with a CO<sub>2</sub> laser at an infrared wavelength of 10.6 um. The CO<sub>2</sub> laser imaged material is also found to be a poor choice because of the poor resolution obtained indicating damage to the

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photopolymerizable layer. The laser to be used with respect to the originally filed 1993 application "should be such that the laser treatment can ablate the slip film without damage to the photopolymer layer just beneath" as set forth on page 13, lines 9-12, of the instant specification and on page 14 of the 1993 application (as found attached to the Murphy Declaration). The only IR ablatable embodiment given does damage to the photopolymer just beneath and has a polyamide binder that is also outside the scope of the list of binders in the instant claims. Thus, there is no generic disclosure to the instant element because Example 3 describes an element that fails to meet the requirements set forth by the 1993 applicants for their ablatable elements. Thus, the only explicit disclosure to an IR ablatable element is Example 3. The introduction of claim changes which involve narrowing the claims by introducing elements or limitations such as the introduction of a limit to ablatable by infrared radiation supported by the as-filed disclosure is a violation of the written description requirement of 35 U.S.C. 112, first paragraph. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905. The broader "non-infrared actinic radiation" is not fully supported by the original disclosure and claims. The ultraviolet range is essential because the entire scope of the 1993 application is directed to ultraviolet photopolymerizable layers. There is no indication anywhere in the 1993 application that the 1993 applicants intended to encompass any system that was not UV sensitive. The instant claims are not so limited and as such are broader than the 1993 disclosure. The examiner notes that the instant claim language to non-infrared includes photopolymerizable systems actively polymerizable in the visible range. The 1993 application makes no comment or disclosure about visibly imageable systems. Finally, the only support for a layer that could be ablated by infrared laser is that in Example 3 specific to a polyamide. The examiner does note

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that the 1993 disclosure does not exclude the use of infrared or visible lasers and layers that ablate when using infrared or visible lasers. The examiner believes the 1993 application does support the use of IR lasers that meet the requirements set forth above with respect to not damaging the photopolymerizable layer. She agrees that the attempt to use IR lasers in Example 3 met that the 1993 applicants intended all laser ablatable materials that fit their requirement be part of their invention. The examiner holds that no species of the ablatable IR layers sought by applicants is supported by actual reduction to practice. Example 3 does not do this because polyamide binders are excluded from the instant invention. The 1993 application fails to present a single IR ablatable system that functions as desired. Thus, limits to only IR ablatable systems are not supported.

4. Applicant's arguments filed August 14, 2003 have been fully considered but they are not persuasive. Applicants have submitted a Declaration of Rustom Kanga, i.e. Kanga Dec, from one of the inventors. The Declaration is alleged to report the following:

- a. The issue of the unevenness of the plate surface in Example 3 in the application is the "subject of slight modification to laser power and that Dr. Kanga did carry out these minor modifications to laser power prior to the effective filing date of this application and produced excellent results."
- b. Dr. Kanga carried out experiments "with minor modifications to the power of the YAG laser and again achieved excellent results."

Applicants submit "that the experiments conducted by Dr. Kanga show that YAG and CO2 lasers can be optimized and used to produce a photosensitive element without damaging the underlying photopolymerizable layer."

Applicants submit “ that Example 3 does in fact demonstrate that YAG and CO2 lasers are usable in the invention”.

Applicants state “that the attached Decl. Of Kanga shows that slight modifications to laser power in YAG and CO2 laser systems can produce excellent results without damage to the photopolymerizable layer.”

The rejection is made because the examiner believes the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The issue is not what the inventor actually had possession of at the time of filing but what one skilled in the relevant art viewing the specification would reasonably believe the inventor had possession of at the time of filing. Thus, the applicant’s points with respect to the Kanga Dec. do not address this point of what the skilled worker would understand the inventors to have possession of at the time of filing. Applicants do submit that Example 3 is sufficient for support of the proposition that YAG and CO2 lasers are usable in the invention. Dr. Kanga in his Declaration does “believe that the subject matter claimed in the pending claims was clearly described in the June 1993 parent of this application. As a person skilled in the art, upon reading the June 1993 parent of this application, it is *clear that the subject matter currently claimed was reasonably described in the June 1993 patent application such that the skilled person could reasonably reproduce the invention of the currently pending claims.*” This examiner adds the emphasis. Thus, Dr. Kanga offers his skilled opinion to that a skilled person could “reasonably reproduce the invention of the currently pending claims” in view of the June 1993 patent disclosure. The examiner states that this is not the basis of the rejection at hand.

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The issue again is what one skilled in the relevant art viewing the specification would reasonably believe the inventor had possession of at the time of filing. Dr. Kanga does state that he believes that the subject matter claimed in the pending claims (as attached to the last applicant's amendment) was clearly described in the June 1993 parent of this application. His reasons are:

- i. The original specification generically describes using any laser at any wavelength that can ablate the ablatable layer and not damage the photopolymer layer below. The examiner agrees there is no limit on the wavelength of the laser for ablation as long as it does not damage the layer below but she does not agree the level of damage is "to an extent that it cannot subsequently be used as a printing surface" as set forth by Dr. Kanga on page 3 of his Dec.

The examiner believes the IR laser systems in Example 3 do not as disclosed meet the requirement of page 14 of the 1993 application, i.e. *"The wavelength and power of the laser should be such that the laser treatment can ablate the slip film without damage to the photopolymer just beneath."* The *"without damage to the photopolymer just beneath"* standard is much higher than can the imaged plate be used as a printing plate. Applicants in Examples 4-8 of the 1993 application show how to achieve their page 14 requirements. They show it with UV lasers. They do not show it with IR lasers. The examiner states the 1993 application discloses, *"The YAG laser was found to be essentially ineffective in causing any ablation."* She believes a worker of skill in the art would upon reviewing Example 3 would take this disclosure to mean the YAG laser did not work for the system set forth especially in view of the example going forth with the CO2 laser and showing the best result being one where the plate surface was uneven as disclosed in TABLE II. If this CO2 laser result was a working example then one reading the

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specification would assume the YAG laser had to have yield worse results than the CO2 laser because it was “essentially ineffective” in comparison to the CO2 laser in Example 3. A worker of ordinary skill in the art would have assumed both lasers were put to the same test and the YAG laser was found ineffective. The part of Example 3 in the original specification partially cited by Dr. Kanga was “Thus, it was seen that the basic idea of the laser imaged printing plate was demonstrated, and that use of the CO2 laser resulted in thermal ablation with a consequent loss of resolution.” The examiner does not see this disclosure as supporting the use of a YAG laser. What it supports when taken as a whole is that lasers could generally be used to form the ablatable layers. It does not support the genus of infrared lasers. It supports at best CO2 lasers with the system set forth could form printing plates. This is one wavelength in the range of infrared light. It is only one species working. Example 3 also shows one species of laser at an infrared wavelength is “essentially ineffective”. This is the evidence the Examiner points to show a worker of ordinary skill in the art would not have assumed all lasers were encompassed by the instant invention. The examiner does not dispute that the original specification was drawn to any laser that would ablate the uv absorber layer as long as that laser ablated the layer without damaging the layer below. What she does dispute is that the disclosure would lead a worker of ordinary skill in the art to recognize that infrared lasers as a generic species was a limit set forth in the original disclosure. It is a genus between the genus of all lasers and the single species of CO2 laser in example 3. She believes the addition of the “essentially ineffective” YAG laser disclosure in the original specification makes clear the sub genus of infrared laser was not part of the original disclosure in the eyes of a worker of skill in the art. The examiner does believe any laser that would ablate the UV absorber layer and not damage the disclosed

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ultraviolet polymerizable layer below as described by applicants in their original claims and disclosure would have been assumed.

Applicants have pointed to original claims 10 and 11 and a method. Since this application only had nine original claims, the claims being addressed must be those in SN 08/082,689. Applicants have failed to show where this limitation is found in the current application. The current application is a continuation in part of SN 08/082,689. There is no showing that the disclosure of claims 10 and 11 of SN 08/082,689 were part of the disclosure of the current application.

Thus, the examiner retains her rejection as modified. Applicants have failed with argument or Declaration to show that a *worker of skill in the art* would have reasonably understood the scope of the instant claims in question was disclosed in the specification.

The examiner has answered arguments with respect to the Kanga Declaration and Fan below.

5. The Declaration of Rustom Kanga filed August 11, 2003 is here fully considered.

a. The Declaration considered under 37 CFR 1.131 is ineffective to overcome the rejection under 35 USC 112, first paragraph. The reasons are set forth below. Dr.

Kanga is one of the inventors of this application. Dr. Kanga states he is a person who had skill in the relevant art at least as early as 1993. He has considered the claims now active in this application and "As a person skilled in the art, upon reading the June 1993 parent of this application, it is clear that the subject matter currently claimed was reasonably described in the June 1993 patent application such that the skilled person could

reasonably reproduce the invention of the currently pending claims.” Under 12, Dr. Kanga sets forth what he finds as support for claim 10 in the earliest parent application which is critical to perfect the filing date back to the original parent application. He does not address “opaque to non-infrared actinic radiation” found in claim 10. With respect to a photosensitive element and page 3, lines 3-18, there is no generic disclosure for this here. What is here is a narrower genus of a “typical flexographic printing plate”. As to “photopolymerizable material” on page 3, lines 9-13, the disclosure is actually to a photocurable layer which can be formulated from any of a wide variety of known photopolymers, initiators, reactive diluents, fillers, etc. There is no mention of photopolymerizable with respect to this layer in the original specification. The wording here is to the “typical flexographic printing plate” the applicant wanted to modify with his invention. Dr. Kanga cites page 14, lines 15-20 as support for “ablation layer ablatable from the surface of the photopolymerizable layer upon exposure to infrared laser radiation”. These lines are as follows:

*The Laser*

*A laser is employed to precisely remove the slip film exposing the photopolymer underneath to subsequent flood exposure and cure. The wavelength and power of the laser should be such that the laser treatment can ablate the slip film without damage to the photopolymer layer just beneath. Excimer lasers...*

The examiner does not see the genus infrared ablatable layers being disclosed in these lines. Thus, Dr. Kanga’s evidence is insufficient to support the for “ablation layer ablatable from the surface of the photopolymerizable layer upon exposure to infrared laser radiation” for which it is referenced as support. The examiner accepts that an ablation layer ablatable with a laser of sufficient wavelength and power that it is fully

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ablated without damage to the photopolymer layer just beneath is supported by these lines, but there is no generic disclosure to all infrared ablatable layers found in these lines. As to binders and their support, the examiner accepts they are supported for all layers that meet the criteria of ablation set forth on page 14, lines 15-20, not that support is found for their use in all generic infrared ablatable layers without such limits.

Points 6-11 of Dr. Kanga's Declaration appeared to be a Declaration under 37 CFR

1.132. The issue needing address to remove the rejection under 35 USC 112, first paragraph, was what one skilled in the relevant art viewing the specification would reasonably believe the inventor had possession of at the time of filing not what could be reproduced from the application in view of the current claims by one skilled in the art.

The Kanga Declaration under 37 CFR 1.131 after full consideration is ineffective to overcome the rejection under 35 USC 112, first paragraph, set forth above because it does not do this. Dr. Kanga never addresses "opaque to non-infrared actinic radiation" found in claim 10. Dr. Kanga under 8.b. states "Example 3 clearly describes ablation imaging using lasers emitting in the IR range specifically YAG and CO<sub>2</sub> lasers". The examiner notes that the only mention of YAG lasers in Example 3 is that they were "employed for the ablative studies" and "The YAG laser was found to be essentially ineffective in causing any ablation." The examiner sees this as disclosure the YAG laser did not work as the ablation layer sought by applicants. There is no indication in the application that the YAG laser ever worked or would be workable. The title of Example 3 is "Laser Ablation and Imaging Using a Solid-State Sealed CO<sub>2</sub> Laser (10.6 nm)." The examiner sees no disclosure which would lead a worker of skill in the art to assume the YAG laser

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was a viable choice or that the slip layers of the applicant would ablate in the manner set forth on page 14, lines 15-20 of their specification. Example 3 does show that changing power watts with the CO<sub>2</sub> laser did finally achieve a raised image of lettering but the plate surface was uneven as shown in Table II. On page 21, of the parent specification, Exhibit A, is found:

*"Also the resolution was poor for the letters. Thus, it was seen that the basic idea of laser-imaged printing plate was demonstrated, and that use of the CO<sub>2</sub> laser resulted in thermal ablation with a consequent loss in resolution."*

There is no clear showing that the CO<sub>2</sub> laser of Example 3 would ever yield an ablatable layer as required on page 14 only that it could yield basically yield a system that did give an image. The examiner believes this Example 3 would tell a worker of skill in the art that IR lasers were not very promising and that none worked as required on page 14.

However, the showing did not exclude infrared lasers from the generic group of all lasers that would perform as set forth on page 14. The limit of page 14, lines 15-20 is not part of the claimed invention. What applicants have claimed is "one ablation layer which is ablatable by infrared radiation and opaque to non-infrared actinic radiation". Applicants have not linked "opaque to non-infrared actinic radiation" to the photopolymerizable layer of the claim in any manner, but this is an essential part of the original disclosure.

The opacity is present for the reasons set forth by Dr. Kanga but the instant claims do not link the unsupported "opaque to non-infrared actinic radiation" in the ablatable layer to any function in the photopolymerizable layer. There is no requirement that the photopolymerizable layer be UV polymerizable. There is no requirement that the "opaque to non-infrared actinic radiation" be from the UV absorber which is another part

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of the original invention since the slip layers being modified were to be transparent to the wavelength of light used to polymerized the photocurable layer. It was the purpose of the UV absorber to change the transparent slip layer to the opaque slip layer.

b. Under 13 of the Declaration, Dr. Kanga discloses "he had possession of the invention claimed currently pending claims "far before the filing date of the '837 Patent..." From this point on the Declaration appears to have been submitted under 37 CFR 1.131. Thus, the issues are completely different from those of 35 USC 112, first paragraph. Dr. Kanga is now apparently trying to remove Fan (6,238,837) as a reference by "swearing back of the reference". Since the Declaration does not address the issue of where the work documented occurred, it is not clear all the work cited occurred in the United States which would be part of the requirements under 37 CFR 1.131. Exhibit G has a Lexington MA address and references a public disclosure to Mr. Terry Feeley in Atlanta Georgia but no record of said disclosure is attached and that the idea was written down in Grace notebooks. There is no clear statement that all of the documented evidence is to work done in the US prior to the date of interest. Thus, it is not clear that prior invention in the US can be established from the Declaration for this reason alone. The invention claimed by applicants is not that claimed by Fan, so the "swearing back" is not excluded for that reason under 37 CFR 1.131. Applicants have not mentioned interference with respect to Fan. Thus, instant applicants are not claiming the identical invention of Fan in the sense of 37 CFR 1.601 (n), that is:

(n) Invention "A" is the *same patentable invention* as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a *separate patentable invention* with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious

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(35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

Fan claims elements that have limits to compatibility and molecular weight and tackiness not found in the instant claims or application. Fan requires the presence of a monomer in his photopolymerizable layers. Applicants make no mention of photopolymerizable layers or monomers in their original disclosures of any of their applications. Applicants refer to photocurable layers and photopolymers. Thus, all the limits of Fan are not present applicant's invention. Nor is there reference to monomer or the desire to avoid migration of monomer or plasticizer from one layer to another as in Fan.

Thus, the examiner now considers the evidence given by Dr. Kanga in his declaration with respect to "swearing back behind" Fan.

Dr. Kanga argues that the parent specification which he references as "the June 1993 patent application, i.e. U.S. Patent application 08/082,689, clearly and effectively discloses the invention of the instant claims as set forth in Exhibit B. This issue has already been addressed above. He also states the said invention set forth in Exhibit B was clearly in his possession prior to June 25, 1993. What is at issue is only that not clearly and effectively disclosed in the U.S. Patent application 08/082,689 as of June 25, 1993. The reduction to practice by Dr. Kanga outside the filing of U.S. Patent application 08/082,689 is Exhibit G. It appears to be the same composition set forth in the examples in 08/082,689 but with the wording that it gave "a great image quality plate". No such disclosure is found in 08/082,689. Thus, the "a great image quality plate" must be considered in view of the disclosure in SN 08/479,339 filed June 7, 1995.

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There is no generic claim to infrared ablation layers in the original disclosure of SN 08/479,339. There is no generic disclosure to "opaque to non-infrared actinic radiation" slip layer either. This does not become part of the claimed invention until the preliminary amendment filed August 8, 2001 in this application. Dr. Kanga does not show he had reduced to practice by Jun 25, 1993 the generic "opaque to non-infrared actinic radiation" slip layer or the generic infrared ablation layers. At best, he shows one species of CO2 laser abatable system, however, one species is insufficient in view of the showing many do not work. The examiner finds nowhere in the Exhibits presented success with a YAG laser. The examiner finds nowhere in the Exhibits the consideration of any system outside of a photocurable UV system as described in U.S. Patent application 08/082,689 thus, the scope of showing is insufficient to support the genus claimed. There is no clear evidence to support the showing of a photopolymerizable plate being used. The Declaration of Dr. Kanga does not remove Fan as a reference.

1. Claims 10-14, 17-20 are rejected under 35 U.S.C. 102(e) or (a) as being anticipated by Fan (6,238,837 B1) (and EP equivalent EP 0741330 A1) and optionally further evidenced by Toda et al (4,045,231), Heinz et al (4,430,417) and Chen (4,323,636) cited by Fan in col. 4, lines 26-29, to disclose block polymers to be used by Fan. Fan (6,238,837 B1) cited by applicants has a filing date of May 1, 1995 which is before the filing date of the oldest effective filing date of the same application, i.e. 08/479,339 filed June 7, 1995. However, the oldest effective filing date is June 25, 1993 drawn to a continuation-in-part of US sn 08/082,689. The examiner has read this oldest application and found the same data supporting an IR ablatable layer in both the current application and the oldest application. It is a series of tests showing that the YAG laser

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does not ablate the instant layers but the CO2 laser does with specific polyamide layers, but also damages the underlying polymerizable layer. However, the CO2 laser does work. However, the instant claims 10-20 are the only support found for the breadth of scope now claimed by applicants and that date of claim submission is August 3, 2001. Thus, Fan is seen as prior art with respect to these claims wherein support is not found in the applications as filed. Fan anticipates the instant element wherein butadiene-styrene block polymers are listed as one choice of binder in the photopolymerizable layer and triblocks such as those of Heinz et al in col. One and those of Chen in col. 1 inclusive of styrene-isoprene and styrene-butadiene di and tri block elastomers. The examiner notes the element claimed by Fan is limited to the presence of a monomer as well as an elastomeric binder. However, the process of imaging with an infrared ablatable layer comprised of a binder that can be a polyamide or hydroxypropylcellulose is disclosed in the examples. In Fan, see particularly Abstract, col. 2, lines 8-10, 23-28, col. 3, lines 48-65, col. 4, lines 20-31, 55-61, col. 5, lines 65-67, col. 6, lines 1-35, col. 7, lines 55-63, col. 9, lines 10-col. 10, lines 48, col. 12, lines 8-col. 13, lines 40, Examples and claims. Thus, with respect to instant claims 10-14, 17-18, the elements of Fan anticipate the instant elements and are held to inherently absorb infrared radiation at a wavelength of 10.6 um. Thus, with respect to instant claims 10-14, 17-18, the elements of Fan anticipate the instant elements and are held to inherently absorb infrared radiation at a wavelength of 10.6 um.

2. Claim 10 is rejected under 35 USC 03(a) as being unpatentable over Scott Paper Company (GB 1,492,070) in view of the Murphy Declaration filed October 24, 2002 further in view of Law et al (4,492,750). The rejection stands for reasons of record set forth in paragraph 4 pages 21-23 in the office action mailed February 27, 2003.

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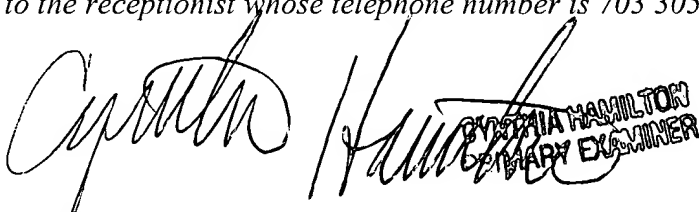
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is (703) 308-3626. The examiner can normally be reached on Monday-Friday, 9:30 am to 5:00 pm.*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on (703) 308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 0661.*



Primary Examiner Cynthia Hamilton  
November 2, 2003